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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,769	09/14/2006	Werner Reinhart	1093-146 PCT/US	9833
23869 7590 10/07/2009 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791				
EXAMINER				
JOY, DAVID J				
ART UNIT		PAPER NUMBER		
1794				
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10/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/561,769

## Applicant(s)

REINHART ET AL.

## Examiner

David J. Joy

## Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 12/21/2005; 04/23/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure:

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-3 are indefinite due to the recitation of the limitations “being capable of establishing a contrast on a scale identified as global at the level of the document” (Claim 1), “on a scale identified as detail at the level of the document” (Claim 1), “established on said detail scale” (Claims 2 and 3). Said limitations are indefinite due to the fact that it is unclear what those claim limitations mean, and the specification fails to provide any adequate explanation as to the meaning of those claim limitations.

6. Claims 4-28 are rejected accordingly, as they all depend upon Claim 1.

7. The terms “generally”, “recognizable”, “purely”, “sufficiently” and “immediately” in Claims 1, 4, 7, 9, 10, 12-15, 17-21, 25 and 26 are relative terms which

render the claims indefinite. The terms "generally", "recognizable", "purely", "sufficiently" and "immediately" are not defined by the respective claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

8. Claims 2, 3, 5, 6, 8, 11, 16, 22-24, 27 and 28 are rejected accordingly, as they all depend upon Claim 1.

9. Claim 7 recites the limitation "said optically active structures" in Line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent Application Publication of Holmes et al. (2003/0058491; hereinafter "Holmes").

12. Holmes teaches a strip for safeguarding a document ("optically variable security device") comprising a support ("carrier") on which there is formed in the longitudinal direction of the strip alternating metallized regions and transparent regions, and the strip contains optically active elements in either the metallized or transparent regions (see Abstract; see also Figure 5c; see also ¶¶ [0001], [0004], [0052] and [0055]). Holmes also teaches that the strip produces an optical effect that is dependent on the angle of observation of the strip, and that the strip also establishes a contrasting color shift on the document, thereby securing documents and articles against counterfeiting (see ¶¶ [0001], [0003] and [0006]). Holmes recites that the transparent regions (i.e., the regions located between 20 and 50 in Figure 5c) are associated with a varnish coating (i.e., 34) (see Figure 5c; see also ¶¶ [0044]-[0055]). Also, Holmes provides that the optical active elements comprise optically variable elements, or optically active structures such as reflective metallized zones, diffractive microstructures, holographic microstructures, demetallized areas of a metallized region, graphical design elements (i.e., "printing"), metallized areas of a transparent region, and diffractive iridescence ("luminescence") (see Figure 5c; see also ¶¶ [0003]-[0006], [0031] and [0044]-[0055]).

13. Additionally, Holmes shows that the metallized regions and the regions containing the optically active structures can be arranged in such a way that the regions are adjacent to one another, given the teaching that the metal layer ("50") can be discontinuous, thereby making it possible to arrange the regions either adjacent to each other, or with an intervening transparent region (see Figures 4a, 4b, 5a, 5b, 5c and 8). Further, Holmes teaches that the holographic element can be provided in such a way that it overlaps the security strip (*id.*). Finally, Holmes expressly provides that the security strip can be integrated as a security thread, and that the thread can be used to safeguard a myriad of security documents (see ¶¶ [0032] and [0055]).

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 6,060,143	05/2000	Tompkins et al.
US 4,943,093	07/1990	Melling et al.
US 4,662,653	05/1987	Greenaway
WO 93/01057	01/1993	Suess

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a



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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/  
Examiner, Art Unit 1794  
09/23/2009

/Bruce H Hess/  
Primary Examiner, Art Unit 1794